

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	Froseth et al.)	
)	Group Art Unit: 1761
)	
Serial Number	09/780,273)	Examiner: Thaker
)	
Filed	February 9, 2001)	Docket No: 869.018US1

For: Customized Food Selection, Ordering and
Distribution System and Method

APPLICANT'S APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants of the above-identified U.S. patent application submit this Appeal Brief in response to the Office Action dated August 15, 2006 and in support of an appeal from the final rejection of claims 128-146 in this application.

REAL PARTY OF INTEREST

The above-identified patent application has been assigned to General Mills which assignment was recorded under Reel No. 011961, Frame 0279.

RELATED APPEALS AND INTERFERENCES

There does not exist any known related appeals or interferences that would directly affect, be directly affected by or have a bearing on the decision in this case.

Serial No., 10/176,072
Applicant's Appeal Brief

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

STATUS OF CLAIMS

Claims 128-146 stand finally rejected and are herewith appealed.

STATUS OF AMENDMENTS

No amendments of the claims have been made to the application after the final rejection dated August 15, 2006.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, as covered by claims 128-134 and 144 is directed to a customized food product. The customized food product includes at least one consumer selected food ingredient, at least one a consumer selected additive and a customer selected package in which the selected food ingredient and additive are placed as set forth in independent claim 128. The selected food ingredient may be popcorn (claim 129), the additive may be a sweetener (claim 130), particularly sucralose (claim 131), with or without additional acesulfame K (claim 134) and the customized food product may be finished by the consumer, such as by popping the popcorn in the selected package (claim 133).

Claim set 135-137 and 145 is limited to a preferred popcorn snack comprising popcorn, sucralose and a package containing both the popcorn and sucralose. The popcorn snack requires popping (claim 136) and can also include acesulfame K (claim 137).

Claims 138-143 and 146 cover a method for preparing a food product by adding sucralose to popcorn and packaging the popcorn and sucralose for distribution. The package may also include acesulfame K (claim 139) and requires further popping or cooking by the consumer (claims 140-142), preferably microwave cooking (claim 143).

Serial No., 10/176,072
Applicant's Appeal Brief

The present Application includes references to a "customized food product" and the various ingredients that may be utilized. See, for example the listing of ingredients in paragraph 0060 or 0123 of the published application. Examples of the additives and packaging that may be utilized can be found in paragraphs 0059 and 0194, respectively, of the published application. The food product can be a popcorn snack as is set forth in paragraph 0068, while the additive can constitute a sweetener, which may be acesulfame K and/or sucralose as set forth in paragraphs 0059, 0071-0073, and 0095. The consumer can further "finish" food product, such as by cooking, baking, grilling, heating, puffing, popping, etc., as set forth in paragraph 0276, or through the use of thermal or microwave energy as set forth in paragraph 0078.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claim 128 is rejected under 35 U.S.C. §112, second paragraph.
2. Claims 128-130 and 144 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain Patent No. 2,250,266 to Ezzat.
3. Claim 128 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,802,599 to Callahan.
4. Claim 128 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,997,924 to Olander, Jr. et al.
5. Claims 131-143, 145 and 146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat in view of U.S. Patent No. 5,120,563 to Mohlenkamp, Jr. et al. and Google Groups.
6. Claims 138-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat, Mohlenkamp, Jr. et al., and Google Groups in view of Callahan.

Serial No., 10/176,072
Applicant's Appeal Brief

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

ARGUMENTS

Applicants respectfully submit that claims 128-146 are patentable and nonobvious over the cited references. Each of the limitations of claim 128 have a definite meaning such that claim 128 is in proper form for allowance. As will be explained below, claims 128-130 and 144 are not anticipated by the prior art because each and every element of the respective claims is not found in a single prior art reference. Additionally, as also explained below, a prima facie case of obviousness has not been established for claims 131-143, 145 and 146 because: (1) the asserted reference combination fails to teach all claimed limitations and/or limitations have not been addressed; (2) there is no motivation or suggestion to combine the prior art in the manner suggested by the Examiner; (3) there is no reasonable expectation of success for the proposed modification; and/or (4) even if the prior art was combined, the combination would still not suggest the claimed invention.

I. Claim 128 rejection under 35 U.S.C. §112, second paragraph

Initially, it should be noted that the Applicant has presented numerous different claim sets in this case, not out of a particular desire to do so, but out of necessity in an attempt to make the series of Examiners who have handled this application realize that the numerous formal claim rejections made in the application to date have been misplaced. As one such formal rejection is still being applied, the Applicant feels forced to bring all of the claims to appeal.

On page 2 of the Office Action, the Examiner states that claim 128 is indefinite because the claim recites the limitation of "customized" in the first line of the claim, and "it is unclear as to what the Applicant regards as a customized food product." The Applicant does not understand why the Examiner is unclear as to the meaning of "customized". The title of the Application includes the word "customized", the Field section of the application states "The present invention relates to systems and methods of

Serial No., 10/176,072
Applicant's Appeal Brief

ordering and distributing food, and in particular to a customized food selection, ordering and distribution system and method", the Background and/or Summary talk about allowing consumers to "create a customized food product" based on available selections, such as by telephone, the internet or the like, and the specification has an incredibly detailed description with reference to forty-nine (49) drawings. Aside from the fact that acknowledging the clear meaning of this term in the claims and giving the term proper patentable weight would clearly require the Examiner to withdraw at least all of the anticipatory rejections, the Applicant can simply not comprehend why this rejection is being applied. If "customized" is unclear in independent claim 128, why are the claims dependent from claim 128 not considered indefinite for the same reason? In any case, just for example, the Summary of the invention notes that, in one embodiment, "the consumer designs or creates his or her own customized food product, such as a cereal or snack product. In another embodiment, the consumer customizes known products as to quantity and type of various additives." See page 3, lines 20-22 of the filed Application. This system addresses the need for food products that can meet the varied needs of each individual consumer. See page 3, lines 1-2 of the filed Application.

As set forth in the M.P.E.P., definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See M.P.E.P. §2173.02. The Applicant respectfully submits that the term "customized" when read in the proper light based on the disclosure, has a clear and definite meaning, such that the rejection of claim 128 under §112, second paragraph, should be reversed.

Serial No., 10/176,072
Applicant's Appeal Brief

II. Claims 128-130 and 144 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain Patent No. 2,250,266 to Ezzat.

A. Claims 128-130

The Applicant respectfully submits that claims 128-130 are patentable over Ezzat. A claim is anticipated under 35 U.S.C. 102(b) only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Initially, the Applicant notes that nowhere in Ezzat is there a teaching or suggestion for consumer customization of a packaged food product as is required in claim 128. Ezzat discusses a sealed bag containing corn kernels and spices which are popped to form classic popcorn. The Examiner asserts that the product in Ezzat is customized simply because food packages containing butter, sugar, salt or other combination thereof have been dispensed into a container with unpopped kernels. See page 3 of the Final Office Action. The Applicant respectfully disagrees. As set forth in Ezzat, "the package consists of a paper bag inside of which there is a certain amount of corn kernels and spices necessary so that, by heating, classic popcorn is formed". See page 1, lines 6- 10 of Ezzat. There is simply no teaching or suggestion in Ezzat for a consumer to choose a food ingredient, an additive and a package as required by claims 128-130.

The MPEP clearly outlines examination guidelines including the court reminded instruction of: "The goal is to answer the question 'What did applicants invent?'" See *In re Abele*, 684 F.2d 902, 907, 214 USPQ 682, 687 (Fed. Cir. 1992) and MPEP 2106. MPEP 2106 goes on to require the Examiner to "evaluate each claim limitation..." and to "correlate each claim limitation to all portions of the disclosure that describe the claim limitation..." The "claim as a whole must be considered" and "when evaluating the scope of a claim, every limitation in the claim must be considered. In the present case, Ezzat has absolutely no disclosure of any analogous customized food arrangement.

Serial No., 10/176,072
Applicant's Appeal Brief

Instead, Ezzat is specifically concerned with preparing a predetermined, pre-packaged food product which a consumer would have to directly select off a supermarket shelf or the like. The consumer only determines whether to buy the product, but has no direct input on the contents of the main ingredient, on the decision of the particular additive(s) included or on the selection of the package in which the ingredients and additives are placed. Ezzat clearly outlines that the disclosed popcorn package is "marketed in a transparent cover" (see page 2, lines 8+), with the package being microwavable. Clearly the consumer did not have an input into which particular container the ingredients were placed. Instead, the decision is predetermined by the manufacturer. Given a proper interpretation and patentable weight to the "customized" aspect of the invention, Ezzat cannot be considered to anticipate the present invention.

B. Claim 144

Claim 144 is dependent on claim 131, which the Examiner has not rejected under this section based on the teachings in Ezzat. Presumably, as claim 131 is patentable over Ezzat, then dependent claim 144 should also be clearly distinguishing.

III. Claim 128 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,802,599 to Callahan.

In connection with this rejection, the Applicant would at least concede that Callahan is concerned with some type of food product customization. However, since the Examiner does not know what "customized" is in accordance with this claim, the Applicant is left to wonder why this reference was employed. Regardless, the Applicant respectfully submits that claim 128 is patentable over Callahan, particularly since Callahan does not disclose the combination of a food selected by a consumer and a package selected by the consumer as required by claim 128. In making this rejection, the Examiner specifically relies on portions of Callahan that only discuss the options of adding cream or sugar to coffee, and discharging the coffee to a cup or other receptacle.

Serial No., 10/176,072
Applicant's Appeal Brief

See page 3 of the Office Action, as well as column 3, lines 15-17 and column 4, lines 36-45 of Callahan. However, it is respectfully submitted that obtaining coffee from a coffee vending machine does not equate to the customized food product of the invention, particularly as the claimed limitations cannot be read in a vacuum but must be read in light of the specification. First, a beverage is not a food product as claimed. The present specification clearly references only edible items when referring to the resulting food product. The Applicant is not requesting that limitations from the specification be read into the claims, but that the claims only be read consistent with the specification. Second, the machine in Callahan only dispenses coffee. Therefore, the consumer does not select a food ingredient in a manner analogous to the invention. Third, the package of the invention must contain the food ingredient and the additive. Consistent with the customization of the invention, the package is sealed in order to "contain" the food ingredient and additive, unlike the arrangement in Callahan. At least for these reasons, Callahan does not teach all the limitations of claims 128, and therefore claim 128 is not anticipated by Callahan. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

IV. Claim 128 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,997,924 to Olander, Jr. et al.

The Applicant respectfully submits that claim 128 is patentable over Olander, Jr. et al. which is directed to an automated process for making pizza. In essence, a display allows desired toppings to be selected by a consumer, then the toppings are added to a crust, the pizza is cooked, cut and packaged in "a cardboard box, carton, disposable plate, etc. for transport, (carrying) or take-out by the customer..." See column 2, lines 22-29 of Olander. Again, a proper interpretation of the customized food product arrangement of the invention would lead one to realize that Olander, Jr. et al. is not concerned with the claimed invention. Regardless, nowhere in Olander, Jr. et al. is there a teaching or suggestion for a customized food product comprising a food ingredient selected by a consumer; an additive selected by the consumer; and **a package selected by the**

Serial No., 10/176,072
Applicant's Appeal Brief

consumer. Rather, in Olander, an automated pizza making process includes the step of putting a cooked pizza into a predetermined container. The fact that the container used in the automated process of Olander could be any one of a number of container types is irrelevant as the consumer does not select the packaging. Again, a claim is only anticipated under 35 U.S.C. 102(b) if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

V. Claims 131-143, 145 and 146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat in view of U.S. Patent No. 5,120,563 to Mohlenkamp, Jr. et al. and Google Groups.

The Applicant respectfully submits that a prima facie case of obviousness has not been established with respect to these claims. Three requirements must be met to show a prima facie case of obviousness under 35 U.S.C. §103: (1) the prior art references must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings; and (3) there must be a reasonable expectation of success. See M.P.E.P. §2143. In determining the propriety of the Patent Office case for obviousness, it is necessary to ascertain whether or not the teachings in the references would be sufficient for one of ordinary skill in the relevant art, having the references before him/her, to make the proposed substitution, combination, or other modification. See M.P.E.P. §2143.01 (citing *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (C.C.P.A. 1972).

A. Claims 131 and 132

The combined prior art references do not teach or suggest all the limitations of claim 131. First of all, there is no teaching or suggestion in the applied prior art to make

Serial No., 10/176,072
Applicant's Appeal Brief

a **customized** food product analogous to the present invention. The Examiner asserts that the product in Ezzat is customized simply because food packages containing butter, sugar, salt or other combination thereof have been dispensed into a container with unpopped kernels. See page 3 of the Final Office Action. The Applicant respectfully disagrees. As previously discussed above, Ezzat discusses a sealed bag containing corn kernels and spices, which are popped to form classic popcorn. No selection process was performed by the consumer in determining what ingredients and additives went into the package, or what type of package was utilized. At best, the consumer merely decided whether or not to buy a pre-packaged food product. As set forth in Ezzat, "the package consists of a paper bag inside of which there is a certain amount of corn kernels and spices necessary so that, by heating, classic popcorn is formed". See page 1, lines 6- 10 of Ezzat. There is simply no teaching or suggestion in Ezzat for a consumer to choose a food ingredient, an additive and a package as required by these claims. To this end, the arguments presented above with respect to the basic distinctions between the subject matter of independent claim 128, from which these claims depend, and Ezzat equally apply here.

More important in connection with the combination presented, the Examiner cites Mahlenkamp for the use of acesulfame K as an alternative to table sugar and the Google Groups reference for using Splenda instead of Sugar Twin®. *Id.* Initially, it should be noted that, for purposes of claims 131 and 132, Mahlenkamp is not seen to be at all pertinent as the acesulfame K limitation is in claim 134, 137 and 139. Because of this, the actual references used in rejecting claims 131 and 132 are unclear. That is, it is not totally clear to Applicant if the Examiner believes there is some significance or need to first modify Ezzat to include acesulfame K in order to further modify Ezzat to include sucralose, or perhaps the listing of Mahlenkamp in rejecting these claims by the Examiner is simply an oversight.

In any case, with respect to the inclusion of the sucralose in the overall combination of the invention, this feature is seen to be particularly important to the

Serial No., 10/176,072
Applicant's Appeal Brief

overall invention. As admitted by the Examiner, Ezzat does not disclose the use of sucralose. See page 5 of the Office Action. Instead, the Examiner relies upon the Google Groups reference which **only suggests sprinkling Splenda® (sucralose) on previously popped popcorn** instead of Sugar Twin®. At best, this combination would suggest sprinkling sucralose onto the popcorn of Ezzat **after** the popcorn is cooked. In contrast, claims 131 and 132 require the sucralose to be pre-packaged with the popcorn. Therefore, none of the prior art, taken either alone or in combination, teaches or suggests a packaged popcorn product including sucralose.

B. Claim 133

Considering the limitations of claim 133 further brings out the distinctions raised above with respect to the rejection of claims 131 and 132, which arguments are incorporated herein by reference. Particularly, in accordance with claim 133, the customized food product, which must include popcorn and sucralose in a package, is popped. Therefore, the combination of the popcorn and sucralose is heated and cooked. As the Google Groups reference is limited in only suggesting the sprinkling of sucralose on popcorn after the popcorn has been popped, the limitations of claim 133 are seen to be further distinguishing. In particular, there is considered to be a significant difference between sprinkling sucralose on a pre-cooked food item wherein the sucralose itself will not be heated to the degree needed to cook the food (in this case the temperature needed to pop the popcorn) and adding the sucralose before cooking so that the chemical composition of the sucralose itself is affected. Therefore, it is respectfully submitted that, without a specific teaching to adding the sucralose to the popcorn of Ezzat before popping the popcorn, the combination of Ezzat in view of Google Groups does not meet the claimed limitations. Instead, it is submitted that the Google Groups reference actually teaches away from such an arrangement by only being limited to the post-cooking application of the sucralose.

Serial No., 10/176,072
Applicant's Appeal Brief

C. Claim 134

As indicated above, the Examiner has relied on Mahlenkamp for the use of acesulfame K as an alternative to table sugar. The Applicant would first like to point out that claim 134 depends from claim 131 which requires the sweetener to be sucralose. With respect to the combination, the Applicant would simply like to submit that there is simply no reason of record, absent hindsight of the present invention, to utilize both sucralose and acesulfame K as sweeteners on the popcorn of Ezzat. Why both? More importantly, where in the references is there any suggestion to utilize both? As stated by the Federal Circuit: "[o]bviousness cannot be established by combining the teachings of the prior art to product the claimed invention, absent some teaching suggestion or incentive supporting the combination." *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). As stated by the CAFC in *In re Gordon*, 221, USPQ 1125, 1127 (1984): The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (*Case citations.*) Based on the above, it is simply, respectfully submitted that a proper prima facie case of obviousness has not been established.

D. Claim 135 and 145

With respect to claims 135 and 145, it is respectfully submitted that the Examiner has failed to provide the requisite suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, for the combination. As indicated above, considered important in accordance with the present invention is the inclusion of sucralose as a pre-packaged sweetener with the popcorn. As admitted by the Examiner, Ezzat does not disclose the use of sucralose. See page 5 of the Office Action. Instead, the Examiner relies upon the Google Groups reference which suggests sprinkling Splenda® (sucralose) on **popped** popcorn instead of Sugar Twin®. At best, this combination would suggest sprinkling sucralose onto the popcorn of Ezzat after the popcorn is cooked. In contrast, claims 135 and 145 require the

Serial No., 10/176,072
Applicant's Appeal Brief

sucralose to the pre-packaged with the popcorn. In the combination suggest by the Examiner, at best, the sucralose would be subsequently added as the Google Groups reference only suggests a subsequent application.

E. Claim 136

In a manner corresponding to that argued above with respect to the limitations of claim 133, claim 136 specifically requires the sucralose to be added to the popcorn prior to popping of the popcorn. In this way, the sucralose is heated when the popcorn is popped rather than just being sprinkled on later to get a desired level of sweetening. There is simply no motivation provided by Google Groups to utilize Splenda in a packaged uncooked popcorn product. The Examiner appears to be arguing that sucralose and sugar are equivalents. This is simply not the case. Sugar and sugar substitutes have different chemical structures and react in vastly differently ways when processed, consumed and/or heated. There is certainly no suggestion in Ezzat as to the desirability of using a sugar substitute for any purpose and the Google Groups reference is actually seen to teach away from applying sucralose to popcorn prior to popping of the popcorn.

Motivation to combine the references must come from within the references themselves and cannot be generated by "hindsight or reconstruction." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). The mere fact that the prior art *may* be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. As set forth by the CAFC in *In re Deuel*:

"Obvious to try" has long been held not to constitute obviousness. A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. In re Deuel, 51 F.3d 1552, 1559 (Fed. Cir. 1995).

Serial No., 10/176,072
Applicant's Appeal Brief

E. Claim 137

For reasons directly corresponding to those discussed above with respect to the particular limitations of claim 134, it is respectfully submitted that a proper prima facie case of obviousness has not been established in rejecting claim 137. Again, the Examiner has relied on Mahlenkamp for the use of acesulfame K as an alternative to the sugar in Ezzat. As claim 137 depends from claim 135, claim 137 requires the popcorn snack to include both acesulfame K and sucralose. In the combination, the Examiner lacks any suggestion to even utilize multiple, different sweetening ingredients with packaged popcorn, let alone the specific combination of sucralose and acesulfame K.

F. Claims 138, 140 and 146

Method claim 138 was specifically added to the application to clearly set forth that the preferred embodiment of the invention adds the sucralose to the popcorn and then packages the popcorn and sucralose for distribution. It is submitted to be clear that the post-application of sucralose to a packaged popcorn does not meet the limitations of this method claim. As referenced above, the inclusion of sucralose as a pre-packaged sweetener with the popcorn is considered an important improvement. As admitted by the Examiner, Ezzat does not disclose the use of sucralose. See page 5 of the Office Action. The Google Groups reference only suggests sprinkling Splenda® (sucralose) on popcorn after the popcorn is popped. Again, this combination would, at best, suggest sprinkling sucralose onto the popcorn of Ezzat after the popcorn is cooked. In contrast, these claims require the sucralose to be pre-packaged with the popcorn. More specifically, **the sucralose has to be prepackaged with the popcorn for distribution.** In the combination suggested by the Examiner, at best, the sucralose would be subsequently added as the Google Groups reference only suggests a subsequent application such that no method is disclosed or suggested by the applied prior art wherein sucralose is added to popcorn and packaged for distribution as claimed.

Serial No., 10/176,072
Applicant's Appeal Brief

G. Claim 139

Like claims 134 and 137, claim 139 requires the combination of popcorn, sucralose and acesulfame K. For reasons directly corresponding to those discussed above with reference to claims 134 and 137, it is respectfully submitted that a proper prima facie case of obviousness has not been established in rejecting claim 139. Again, the Examiner has relied on Mahlenkamp for the use of acesulfame K as an alternative to the sugar in Ezzat. There is simply no teaching or suggestion in the applied prior art to further add acesulfame K to the sucralose and popcorn packaged in accordance with claim 135. That is, the combination lacks any suggestion to utilize multiple, different sweetening ingredients with packaged popcorn, let alone the specific combination of sucralose and acesulfame K.

H. Claims 141 and 142

Claims 141 and 142 require popping or otherwise cooking the packaged popcorn and sucralose. In this sense, these method limitations find certain correspondence in product claims 133 and 136 such that the arguments presented above will not be fully reiterated but are rather incorporated by reference. In any case, there is simply no motivation provided by Google Groups to utilize sucralose in a packaged uncooked popcorn product. In fact, the reference specifically teaches away from such an arrangement in dealing only with the post-application of sucralose. In addition, it is respectfully submitted that the Examiner is wrong in the position that sugar and sucralose are equivalents. Sugar and sugar substitutes have different chemical structures and react in vastly differently ways when processed, consumed and/or heated. Cooking the sucralose reference by the Google Groups would change chemical and physical properties of the sucralose which is not even remotely considered/suggested by the reference or in the combination presented.

Serial No., 10/176,072
Applicant's Appeal Brief

I. Claim 143

Claim 143 is seen to further bring out the distinction raised above with respect to the rejection of claim 142. With respect to claim 143, it is respectfully submitted that the Examiner has failed to provide the requisite suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and has failed to establish a reasonable expectation of success in combining cited references. In accordance with claim 143, the finished food product, including the popcorn and sucralose, must be microwaved. The Examiner noted that sweeteners exist as a substitute to sugar for diet conscious consumers, citing Google Groups. However, this is not the same as sweeteners existing as substitutes for sugar in **cooking**. Numerous sweeteners available on the market just cannot be utilized in the same manner as sugar. This is even more important when the cooking method being utilized is microwave energy. Unlike conventional cooking which utilizes convection principles, microwave heating involves the application of wavelength energy to excite molecular bonds in food. The effect of microwaves on food additives can be vastly different than the effect of conventional cooking methods on the same additives. For example aspartame, one of the sweeteners pointed out by the Examiner (see page 5 of the Office Action) is thermally unstable under microwave heating conditions and is unsuitable as a sugar substitute in microwave cooking. The Google Groups reference simply does not teach utilizing sucralose as a sugar substitute in cooking, let alone microwave cooking. Furthermore, there is simply no suggestion in Ezzat as to the desirability of using a sugar substitute for any purpose, including for the purpose of obtaining a low carbohydrate sweet and salted popcorn product as the Examiner suggests on page 5 of the Office Action. Motivation to combine the references must come from the references themselves, and cannot be generated by "hindsight or reconstruction." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As discussed with reference to claims 135-142, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the

Serial No., 10/176,072
Applicant's Appeal Brief

desirability of the modification. An "Obvious to try" approach does not establish a proper obviousness rejection.

Additionally, there is no teaching in any of the cited art references that would provide one of ordinary skill in the art with a reasonable expectation of success in substituting Splenda® for sugar in a packaged **microwave** popcorn snack. Again, additives can have vastly different reactions during microwave heating then during convection cooking or when used with no heating at all. The Examiner has provided only a reference citing the use of Splenda® on already popped popcorn, where no heating of the sugar substitute is suggested. Microwaving a food product will inherently produce hot spots which would not be the case in connection with baking a food product containing sucralose. That is, it would not be unusual to develop localized heating in the microwave to over 400°F. Such temperatures would be considered too high for sweeteners as the sweeteners would char. This does not occur with the sucralose in connection with the invention. Still, taste is a concern and therefore some embodiments of the invention also employ acesulfame K as well. In any case, there are particular circumstances, at least in connection with rapid and localized heating, that are relevant to food products being microwaved and other food products. As the Google Group reference has absolutely no suggestion to microwave sucralose, this claim is seen to be even further distinguishing.

VI. Claims 138-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat, Mohlenkamp, Jr. et al., and Google Groups in view of Callahan.

Initially, it is submitted that this rejection is riddled with inconsistencies. For instance, the Examiner has already rejected claims 138-143 under Ezzat in view of Mohlenkamp, Jr. et al. in view of Google Groups, so why the present need to add the Callahan reference? Is Callahan needed in the mind of the Examiner or not? In addition, on page 6 of the Office Action, the Examiner states that it would have been obvious to modify Ezzat/Google Groups/Mohlenkamp in view of Callahan in order to provide a self-service system for obtaining a customizable product. However, just looking at claim 138

Serial No., 10/176,072
Applicant's Appeal Brief

for example, this claim is directed to a method for preparing a food product by packaging sucralose added to popcorn, but does not require the "customized" aspect of, say, claims 128-134. Therefore, the difference in rejecting these claims with and without Callahan is confusing and inconsistent. Basically, it appears that the Examiner is addressing limitations that are not present in the claims. Furthermore, it is questioned how the combination without Callahan is also considered to render unpatentable various product claims in this case, but when Callahan is added, these limitations are apparently not met. In any case, in this instance, it is respectfully submitted that the Examiner has failed to clearly explain the pertinence of each reference cited as required under 37 C.F.R. 1.104. Regardless, for the sake of completeness, the Applicant has substantially duplicated below the comments made to rebut the rejection of claims 138-143 as set forth above and it is respectfully submitted that each of the points raised are equally applicable to the combination with or without Callahan.

A. Claims 138 and 140

Method claim 138 was specifically added to the application to clearly set forth that the preferred embodiment of the invention adds the sucralose to the popcorn and then packages the popcorn and sucralose for distribution. It is submitted to be clear that the post-application of sucralose to a packaged popcorn does not meet the limitations of this method claim. As referenced above, the inclusion of sucralose as a pre-packaged sweetener with the popcorn is considered an important improvement. As admitted by the Examiner, Ezzat does not disclose the use of sucralose. See page 5 of the Office Action. The Google Groups reference only suggests sprinkling Splenda® (sucralose) on popcorn after the popcorn is popped. Again, this combination would, at best, suggest sprinkling sucralose onto the popcorn of Ezzat after the popcorn is cooked. In contrast, these claims require the sucralose to be pre-packaged with the popcorn. More specifically, the **sucralose has to be prepackaged with the popcorn for distribution.** In the combination suggested by the Examiner, at best, the sucralose would be subsequently added as the Google Groups reference only suggests a subsequent application such that no

Serial No., 10/176,072
Applicant's Appeal Brief

method is disclosed or suggested by the applied prior art wherein sucralose is added to popcorn and packaged for distribution as claimed.

B. Claim 139

Like claims 134 and 137, claim 139 requires the combination of popcorn, sucralose and acesulfame K. For reasons directly corresponding to those discussed above with reference to claims 134 and 137, it is respectfully submitted that a proper prima facie case of obviousness has not been established in rejecting claim 139. Again, the Examiner has relied on Mahlenkamp for the use of acesulfame K as an alternative to the sugar in Ezzat. There is simply no teaching or suggestion in the applied prior art to further add acesulfame K to the sucralose and popcorn packaged in accordance with claim 135. That is, the combination lacks any suggestion to utilize multiple, different sweetening ingredients with packaged popcorn, let alone the specific combination of sucralose and acesulfame K.

C. Claims 141 and 142

Claims 141 and 142 require popping or otherwise cooking the packaged popcorn and sucralose. In this sense, these method limitations find certain correspondence in product claims 133 and 136 such that the arguments presented above will not be fully reiterated but are rather incorporated by reference. In any case, there is simply no motivation provided by Google Groups to utilize sucralose in a packaged uncooked popcorn product. In fact, the reference specifically teaches away from such an arrangement in dealing only with the post-application of sucralose. In addition, it is respectfully submitted that the Examiner is wrong in the position that sugar and sucralose are equivalents. Sugar and sugar substitutes have different chemical structures and react in vastly differently ways when processed, consumed and/or heated. Cooking the sucralose reference by the Google Groups would change chemical and physical

Serial No., 10/176,072
Applicant's Appeal Brief

properties of the sucralose which is not even remotely considered/suggested by the reference or in the combination presented.

D. Claim 143

Claim 143 is seen to further bring out the distinction raised above with respect to the rejection of claim 142. With respect to claim 143, it is respectfully submitted that the Examiner has failed to provide the requisite suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and has failed to establish a reasonable expectation of success in combining cited references. In accordance with claim 143, the finished food product, including the popcorn and sucralose, must be microwaved. The Examiner noted that sweeteners exist as a substitute to sugar for diet conscious consumers, citing Google Groups. However, this is not the same as sweeteners existing as substitutes for sugar in **cooking**. Numerous sweeteners available on the market just cannot be utilized in the same manner as sugar. This is even more important when the cooking method being utilized is microwave energy. Unlike conventional cooking which utilizes convection principles, microwave heating involves the application of wavelength energy to excite molecular bonds in food. The effect of microwaves on food additives can be vastly different than the effect of conventional cooking methods on the same additives. For example aspartame, one of the sweeteners pointed out by the Examiner (see page 5 of the Office Action) is thermally unstable under microwave heating conditions and is unsuitable as a sugar substitute in microwave cooking. The Google Groups reference simply does not teach utilizing sucralose as a sugar substitute in cooking, let alone microwave cooking. Furthermore, there is simply no suggestion in Ezzat as to the desirability of using a sugar substitute for any purpose, including for the purpose of obtaining a low carbohydrate sweet and salted popcorn product as the Examiner suggests on page 5 of the Office Action. Motivation to combine the references must come from the references themselves, and cannot be generated by "hindsight or reconstruction." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837

Serial No., 10/176,072
Applicant's Appeal Brief

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As discussed with reference to claims 135-142, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. An "Obvious to try" approach does not establish a proper obviousness rejection.

Additionally, there is no teaching in any of the cited art references that would provide one of ordinary skill in the art with a reasonable expectation of success in substituting Splenda® for sugar in a packaged **microwave** popcorn snack. Again, additives can have vastly different reactions during microwave heating then during convection cooking or when used with no heating at all. The Examiner has provided only a reference citing the use of Splenda® on already popped popcorn, where no heating of the sugar substitute is suggested. Microwaving a food product will inherently produce hot spots which would not be the case in connection with baking a food product containing sucralose. That is, it would not be unusual to develop localized heating in the microwave to over 400°F. Such temperatures would be considered too high for sweeteners as the sweeteners would char. This does not occur with the sucralose in connection with the invention. Still, taste is a concern and therefore some embodiments of the invention also employ acesulfame K as well. In any case, there are particular circumstances, at least in connection with rapid and localized heating, that are relevant to food products being microwaved and other food products. As the Google Group reference has absolutely no suggestion to microwave sucralose, this claim is seen to be even further distinguishing.

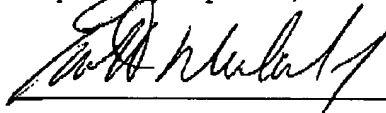
CONCLUSION

It is respectfully submitted that each of the limitations of claim 128 has a definite meaning such that claim 128 is in proper form for allowance under 35 U.S.C. §112, second paragraph. It is further submitted that the Examiner has failed to establish anticipation under 35 U.S.C. §102 in rejecting claims 128-130 and 144. Additionally, the

Serial No., 10/176,072
Applicant's Appeal Brief

Applicant asserts that the Examiner has failed to establish obviousness under 35 U.S.C. §103 in rejecting claims 131-143 and 146 of this Application. Basically, it is the opinion of the Applicant that none of the prior art, when taken singly or in combination, teaches a packaged food product containing popcorn applied with sucralose, and that other features of the invention, particularly the consumer customization, the addition of a further sweetener and the subsequent microwave cooking, even further distinguish the invention from the known prior art. It is also not considered unreasonable for the Applicant to request from the Examiner, should an Examiner's Answer be prepared, to clarify what the level of ordinary skill in the art is considered to be in connection with making any obviousness-type rejections. In trying to understand the positions taken by the Examiner, it would be particularly beneficial in this case to understand the Examiner's reasoning. For instance, is the Examiner considering one of ordinary skill in the art to be a lab technician of a food company like the present inventors, a homemaker, a chef, a food manufacturer, etc.? In any case, it is submitted that the present invention as set forth in this application patentably defines the invention over the known prior art such that the Examiner's rejection should be reversed.

Respectfully requested,



Everett G. Diederiks, Jr.
Associate Attorney for Applicant
Reg. No. 33,323

Date: February 7, 2006
DIEDERIKS & WHITE LAW, PLC
12471 Dillingham Square, #301
Woodbridge, VA 22192
Tel: (703) 583-8300
Fax: (703) 583-8301

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

CLAIMS APPENDIX

1-127. (canceled)

128. (previously presented) A customized food product comprising:

- a food ingredient selected by a consumer;
- an additive selected by the consumer; and
- a package, selected by the consumer, containing the food ingredient and the additive.

129. (previously presented) The customized food product of claim 128, wherein the food product is a popcorn snack and the food ingredient is popcorn.

130. (previously presented) The customized food product of claim 129, wherein the additive is a sweetener.

131. (previously presented) The customized food product of claim 130, wherein the sweetener is sucralose.

132. (previously presented) The customized food product of claim 131, wherein the customized food product requires further finishing by the consumer.

133. (previously presented) The customized food product of claim 132, wherein the customized food product requires popping by the consumer.

134. (previously presented) The customized food product of claim 131, further comprising: acesulfame K in the package.

Application Serial No. 09/780,273
Applicant's Appeal Brief

135. (previously presented) A popcorn snack comprising:
 popcorn;
 sucralose; and
 a package containing the popcorn and the sucralose.
136. (previously presented) The popcorn snack of claim 135, wherein the popcorn snack requires popping by a consumer.
137. (previously presented) The popcorn snack of claim 135, further comprising:
 acesulfame K in the package.
138. (previously presented) A method for preparing a food product comprising:
 adding sucralose to popcorn; and
 packaging the popcorn and sucralose for distribution.
139. (previously presented) The method of claim 138, further comprising: adding
 acesulfame K.
140. (previously presented) The method of claim 138, further comprising: requiring the
 food product to be further finished by a consumer.
141. (previously presented) The method of claim 140, wherein further finishing of the
 food product by the consumer involves popping the popcorn.
142. (previously presented) The method of claim 140, wherein finishing the customized
 food product involves cooking the food product.
143. (previously presented) The method of claim 142, wherein finishing the customized
 food product involves microwave cooking the food product.

Application Serial No. 09/780,273
Applicant's Appeal Brief

144. (previously presented) The customized food product of claim 131, further comprising: a flavoring, selected by the consumer, contained in the package, wherein the flavoring constitutes salt.

145. (previously presented) The popcorn snack of claim 135, further comprising: salt within the package.

146. (previously presented) The method of claim 138, further comprising: adding salt to the popcorn prior to packaging for distribution.

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

EVIDENCE APPENDIX

Not Applicable

RECEIVED
CENTRAL FAX CENTER
FEB 07 2007

RELATED PROCEEDING APPENDIX

Not Applicable